

reference of Kotis; maintained the Office's rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram; and maintained the Office's rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over the combination of the reference of Ingram and the reference of Behensky.

NOTICE OF WITHDRAWAL
FROM APPEAL

In response to the Office's above-mentioned Advisory Action, the Applicant hereby formally request to withdrawal the present case from appeal and respond to the Office's Advisory Action. The Applicant has enclosed a petition for a one-month extension of time and the associated fees for the time extension with the present response. The Applicant's response to the Office's Advisory Action is as follows:

Rejection under 35 U.S.C. 102(b) to Ingram

Applicant's independent claim 18 stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram (U.S. Patent No. 2,500,078). The Applicant respectfully disagrees with the Office's rejection of Applicant's independent claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram for the following reasons.

- A. The reference of Ingram does not teach simultaneous submersion of a bobber main body and the displacement of a member with respect to the bobber main body**

In rejecting independent claim 18 as being anticipated by the reference of Ingram, the Office, on page 2, lines 21-24 of the Office Action of May 19, 2004, stated:

“The patent to Ingram shows a two stage fishing bobber in Fig. 1 having a main body 10 and a member 12 resiliently displaceable with respect to the bobber main body to a force exerted on the member as disclosed in column 2, lines 20-30.”

The Applicant respectfully disagrees with the Office's above statement. Applicant's independent claim 18 calls for a two-stage fishing bobber that is responsive to different fishing forces, the two-stage fishing bobber having:

“... a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

The advantage of providing for a gradual resistance is that:

“... the fish does not notice the sharp resistance of the bobber as the bobber is submerged and is less likely to spit out the bait. That is instead of the fish facing an abrupt jerk on the line by submerging the bobber the fish receives a gradual pull on the line as the spring is compressed and then a further tug as the bobber is submerged. However, since there is already a resistance on the line from compressing the spring the submersion of the bobber does not produce a sharp increase in the force which might cause the fish to spit out the hook.” (Emphasis added, see page 14, lines 18-25 of the Applicant's disclosure.)

It is respectfully submitted that the reference of Ingram does not teach “... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” To the contrary, Ingram in column 2, lines 20-26 specifically states:

“... as a fish strikes the lower end of the line, the attached stem will move downwardly through the bore of the body until the top of the stem is flushed with the top surface of

the body; the body then is subject to the downward pull on the line and will disappear from sight below the surface of the water.” (Emphasis added.)

It is submitted that since Ingram’s attached stem submerges before the body of his fishing float (col. 2, lines 20-26), Ingram’s fishing float thus does not provide for a gradual resistance. In view of the aforementioned, the submersion of Ingram’s body 10 will result in the problem that the Applicant's invention addresses to fix, namely the production of an abrupt jerk or a sharp increase in the force, which may cause the fish to spit out the hook.

It is for the above reason(s) that the Applicant respectfully submits that the reference of Ingram does not anticipate Applicant’s independent claim 18.

B. The reference of Ingram does not teach his device as providing for gradual resistance

Applicant’s claim 18 calls for:

“... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

The Applicant submits that Ingram’s fishing float does not provide for a gradual resistance as called for in Applicant's independent claim 18. Referring to column 2, lines 20-26 of Ingram, note that Ingram instead disclosures that his stem member 12 is pulled downward to a flushed condition before the body of Ingram’s fishing float is subject to the downward Force.

Referring to Figures 1 and 3, also note that Ingram’s stem member 12 is shown to include a lower tapered portion 16, which allows stem member 12 to be displaced in the water with less resistance than if the lower portion of the stem member 12 was not tapered.

Further note that Ingram's body 10, as shown in Ingram's Figures 1 and 3, includes a flat circular-shaped base. The Applicant submits that the flat and circular-shaped base of Ingram's float body 10 will require greater force to downwardly displace the float body 10 in the water than if the base of the body 10 was not flat, i.e. tapered. Since Ingram's stem member 12 submerges before Ingram's fishing float body 10 and since the lower tapered portion 16 of Ingram's stem member 12 allows the stem member 12 to be displaced in a body of water with less resistance than if the stem member 12 was not tapered while the flat and circular-shaped base of Ingram's body 10, on the other hand, will require greater resistance in order to downwardly displace of the float body 10 in the body of water than if the float boy 10 was tapered, the Applicant submits that there will be an abrupt or sharp change in the force of resistance at the point when Ingram's stem member 12 is flushes/displaced and Ingram's float body begins to submerge.

Since there will be an abrupt change in the force of resistance at the point when Ingram's tapered stem member 12 has been displaced/flushed and Ingram's flat based float body begins to submerge the Applicant submits that Ingram's fishing float does not provide for a "gradual resistance." Due to the abrupt or sharp change in the force of resistance at the point in which Ingram's stem is submerged/flushed and Ingram's float body begins to submerge, it is thus submitted that Ingram's fishing float does not provide for a "gradual resistance" as called for in Applicant's independent claim 18.

In regards to the Office's Advisory Action, the Office on page 2, lines 1-3 stated:

"Continuation of 5. does NOT place the application in condition for allowance because: for example in the patent to Ingram, applicant argues that Ingram ddoes not show a gradual resistance. However, since Ingram shows the same structure recited, it follows that Ingram would function in the same manner." (Emphasis added.)

The Applicant respectfully disagrees with the Office's above statement. Firstly, the Applicant traverses the Office's contention that the reference of Ingram shows the same structure recited in Applicant's independent claim 18. More specifically, the reference of Ingram does not teach his device as having a bobber main body and a member in which a force directed on the member (with the force being sufficient to overcome at least some if not all of the buoyant force of the bobber main body) results in:

"... the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance." (Emphasis added.)

To the contrary, note in column 2, lines 20-26 wherein Ingram specifically states that his:

"... attached stem will move downwardly through the bore of the body until the top of the stem is flushed with the top surface of the body; the body then is subject to the downward pull on the line and will disappear from sight below the surface of the water." (Emphasis added.)

It is submitted that since the body of Ingram's fishing float is not subjected to the downward pull on the line until his stem is flushed, that there is no simultaneous submersion of the body of Ingram's fishing float as Ingram's attached stem is being displaced.

In further regards to the Office's contention that Ingram's device would function in the same manner as the fishing float of the Applicant's independent claim 18, the Applicant respectfully

submits that the Office has not provided evidence to support the aforementioned. The Applicant submits that under the case of *In Re Wilder*, any burden of proof as to the cited prior art is initially placed upon the Office and not on the Applicant. See *In Re Wilder*, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970), also see *In re King*, 231 U.S.P.Q. 136, 138-139 (Fed. Cir. 1986). The Applicant submits that the Office has not provided evidence that Ingram's stem member 12 and float body 10 function in the same manner as the Applicant's invention, namely simultaneously submerging to provide for gradual resistance.

It is for the above reasons that applicant submits that the reference of Ingram does not anticipate Applicant's independent claim 18.

Rejection under 35 U.S.C. 102(b) to Kotis

Applicant's independent claim 18 stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Kotis. The Applicant respectfully disagrees with the Office's rejection of Applicant's independent claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Kotis for the following reasons.

A. The reference of Kotis does not teach a member resiliently displaceable with respect to said bobber main body

In rejecting independent claim 18 as being anticipated by the reference of Ingram, the Office, on page 2, lines 16-20 of the Office Action of May 19, 2004, stated:

“The patent to Kotis shows a fishing bobber having a main body 14 and a resiliently displaceable member 10, 15 with respect to the main body of the bobber in response to

a force on member 10, 15 noting that the spring 10 is fixed on the line 11 at 10a as disclosed in column 1, lines 57-60.”

The Applicant respectfully disagrees with the Office's above statement. As previously noted, Applicant's independent claim 18 calls for a two-stage fishing bobber responsive to different fishing forces, the two-stage fishing bobber having:

“... a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body”
(Emphasis added.)

It is submitted that the reference of Kotis does not teach the above, and more specifically, the reference of Kotis does not teach “... a member resiliently displaceable with respect to said bobber main body in response to a force on said member ...” In regards to Kotis' coil 10, note that Kotis' coil 10 is a float stop that is “... frictionally affixed to the fishline ...” and remains at a fix location on the fishing line once the coil is affixed thereon to allow a fishline to self adjust to a desired length with respect to the float when the fishline is thrown in the water with the float 14 thereon. (See column 1, lines 59-61 and column 2, lines 13-15.)

Further note that Kotis specifically discloses in column 1, lines 39-44 that his coil 10 does not have “... spring-like resiliency as in tension and compression springs ...” and that Kotis' bead 15 prevents the downward movement of Kotis' coil 10 with respect to Kotis' float once the Kotis' float is in the stopped condition. (See column 2, lines 13-19; and Figures 1-3 of Kotis.) Since Kotis' coil 10 is frictionally affixed to the fishline and remains at a fix location on the fishing line once the coil is affixed thereon, it is submitted that Kotis' coil 10 thus is not displaceable with respect to the body of his bobber in response to a force on Kotis' coil 10.

In regards to Kotis' bead 15, note that Kotis' bead 15 is "... interposed between the float 14 and one of the end portions 13 of the coil (FIGURES 1 and 3) ..." and functions by urging with an end of Kotis' coil 10 to restrict movement of Kotis' float 14 on the fishing line beyond the location where Kotis' coil 10 is secured to the fishing line. (See column 1, lines 62-65; column 2, lines 13-19; and Figures 1-3 of Kotis.) Further note that Kotis' bead 15 is not displaceable with respect to the body of his bobber in response to a force on Kotis' bead 15 as bead 15 can only move on the fishing line between coil 10 and float 14.

In view of the aforementioned, it is submitted that Kotis' coil 10 and bead 15 are not resiliently displaceable with respect to the body of his float in response to a force directed on the coil 10 or the bead 15 via the fishline.

B. Kotis does not teach simultaneous submersion of a bobber main body and the displacement of a member with respect to the bobber main body

As previously noted, Applicant's claim 18 calls for:

"... a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance." (Emphasis added.)

It is submitted that the reference of Kotis does not teach the above. More specifically, the reference of Kotis does not teach the simultaneous submersion of his float body and a resiliently displaceable member. Note that Kotis' bead 15 prevents the displacement of Kotis'

coil 10 with respect to the body of Kotis' float. (See Figure 3 of Kotis.) Further note that Kotis' bead 15 and coil 10 and the body of Kotis' float are located at different regions on the fishline thereby preventing their simultaneous submersion. More specifically, referring to Kotis' Figure 1 and 3, note that in use in a body of water, Kotis' coil 10 is fixedly located above his float 14 with Kotis' bead 15 located therebetween. As such, a downward force directed on the fishline 11 will result in the submersion of Kotis' float 14 before the submersion of Kotis' coil 10 and before the submersion of Kotis' bead 15.

C. The reference of Kotis does not teach his device as providing for gradual resistance

As previously note, Applicant's independent claim 18 calls for a two-stage fishing bobber responsive to different fishing forces, the two-stage fishing bobber having:

“... a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body”
(Emphasis added.)

The advantage of providing for a gradual resistance is that when a fish strikes the fishing line the fish will not notice a sharp resistance of the bobber as the bobber is being submerged and thus is less likely to spit out the bait compared to situation where there is an abrupt jerk on the line. (Emphasis added, see page 14, lines 18-25 of the Applicant's disclosure.)

The above gradual resistance is accomplished by providing for “... a member resiliently displaceable with respect to said bobber main body, ...” wherein the member is first partially

displaced by an initial downward force directed on the fishline after which the bobber main body and the member are simultaneous submerge in a body of water in response to a further downward force direct on the fishline. That is, the displacement of the member allows the Applicant's fishing bobber to "mask" the greater force required to submerge the Applicant's bobber main body thereby preventing an abrupt jerk on the fishline caused by the submersion of the bobber main body alone.

Unlike the Applicant's invention, Kotis' device does not provide for a gradual resistance since in the operation of Kotis' device, Kotis' float 14 is submerged before the submersion of his coil 10 or his bead 15. That is, Kotis' float does not provide for the displacement of a member having less resistance than the body of his float 14 to "mask" the force required in order to submerge the body of Kotis' float 14. The submerging of Kotis' float 14 thus will result in an abrupt jerk on the fishline caused by the sharp resistance of the Kotis' float 14 as his float 14 is being submerged.

It is for the above reasons that Applicant submits that the reference of Kotis does not anticipate Applicant's independent claim 18.

Rejection under 35 U.S.C. 103(a) to Kotis

Applicant's claims 19-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Kotis. In regards to Applicant's claims 19 and 20, Applicant's claim 19 calls for the two stage fishing bobber of claim 18 wherein:

“... the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.”

Applicant's claim 20 calls for the two stage fishing bobber of claim 18:

“... wherein the resiliently displaceable member comprises a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.”

In rejecting claims 19-20, the Office on page 3, lines 11-22 of the Office Action of May 19, 2004, stated:

“The patent to Kotis shows a fishing bobber as discussed above. Kotis forces down the member 10,15 in response to a force on the line and then the main body will move downwardly as the spring is compressed. It is not clear if the force to displace the member to a down position is substantially equal to the buoyant force of the bobber main body, but it follows that when the member 10 is in the down position, that the bobber main body is submerged since the spring 10 is displaced downwardly, the spring will start to compress and move the main body downwardly. In reference to claims 19-20, it would have been obvious to employ a force to displace the member to a down position that is equal to the buoyant force of the main bobber body so that when the member is in the down position, the bobber main body is submerged since routine experimentation would be used to determine the amounts of force required to submerge the main bobber body and the resilient member.” (Emphasis added.)

The Applicant traverses the Office's above statement. Firstly, it is submitted that a review of the reference of Kotis revealed that the reference of Kotis fails to teach “... the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body ...” as called for in Applicant's claim 19.

Secondly, the Applicant disagrees with the Office's above statements that Kotis' "... main body will move downwardly as the spring is compressed ..." and that Kotis' "... spring will start to compress and move the main body downwardly ..." as the reference of Kotis specifically teaches the opposite of the aforementioned. Note in column 1, lines 39-44 wherein Kotis specifically discloses that Kotis' coil 10 does not have "... spring-like resiliency as in tension and compression springs." Further note in column 1, lines 59-61 and column 2, lines 13-15 wherein Kotis also teaches that his coil 10 is "... frictionally affixed to the fishline ..." and remains at a fix location on the fishing line once the coil is affixed thereon to allow a fishline to self adjust to a desired length with respect to the float when the fishline is thrown in the water with the float 14 thereon. As Kotis' coil 10 does not compress and is "... frictionally affixed to the fishline ..." and remains at a fix location on the fishing line once the coil is affixed thereon, it is submitted that the reference of Kotis does not make Applicant's claim 19 obvious.

In regards to Applicant's claim 20, the Applicant submits that the reference of Kotis does not make Applicant's claim 20 obvious as a review of the reference of Kotis reveals that the reference of Kotis fails to teach or suggest "... a spring whose constant is about equal to the spring constant of the bobber in water ..." as called for in Applicant's claim 20. The reference of Kotis instead, teaches against the Applicant's claim 20 by specifically calling for a coil 10 that does not have "... spring-like resiliency as in tension and compression springs." (See column 1, lines 39-44.)

It is for the above reasons that the Applicant submits that Applicant's claims 19 and 20 are allowable over the reference of Kotis.

Rejection under 35 U.S.C. 103(a) to Ingram

Applicant's claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram. Applicant's claim 19 calls for:

“... the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.”

In rejecting claim 19, the Office stated:

“In reference to claim 19, Ingram does not disclose that the force to displace the member to a down position is equal to the buoyant force of the bobber main body so that when the member is in the down position, the bobber main body is submerged.”
(Page 4, lines 1-4 of the Office Action of May 19, 2004)

The Applicant agrees with the Office's above statement as the reference of Ingram does not teach the force to displace his stem member 12 to a down position as being substantially equal to the buoyant force of Ingram's float body 10. On page 4, lines 4-8 of the Office Action of the Office Action of May 19, 2004, the Office however, further stated:

“... it would have been obvious to employ a main bobber body and a member that have substantially equal forces since routine experimentation would be used to determine the exact values of the forces to displace the member to a down position and the buoyant force of the bobber main body.”

The Applicant traverse the Office's above statement. It is submitted that the issue is not whether routine experimentation can be used to determine the exact values of the forces to

displace the Ingram's hollow shaft member 12 to a down position and the buoyant force of the Ingram's body 10. Instead, the issue is whether the reference of Ingram teaches or suggests a fishing float wherein:

“... the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.

The Applicant submits that the reference of Ingram does not teach or suggest the above. The reference of Ingram, instead, shows a two stage fishing bobber which forces down the member and then the main body. (See Figure 3 of Ingram.) Ingram's purpose for having his stem member 12 displaced "... below the surface of the water ..." before the downward displacement of his float body 10 is to allow his stem member 12 to provide for an indicator of a striking fish. (See column 2, lines 25-30 of Ingram.) It is noted that the employment of a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's float body 10 will result in Ingram's float body 10 being submerged when the Ingram's stem member 10 is in the down position thereby eliminating the specifically disclosed fish striking indication aspect of Ingram's fishing float.

In view of the above, the Applicant submits that employment of routine experiments "... to determine the exact values of the forces to displace the member to a down position and the buoyant force of the bobber main body, ..." as called for by the Office, is a contrary teaching to the reference of Ingram.

It is for the above reasons that the Applicant submits that Applicant's claim 19 is allowable over the reference of Ingram.

Rejection under 35 U.S.C. 103(a) to Ingram and Behensky

- A. It would not have been obvious to combine the reference of Ingram with the reference of Behensky**
- a. Behensky's tube 10, cap member 15, and spring 16 are not an equivalent mechanical member to Ingram's stem member 12.**

Applicant's claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ingram and Behensky. Applicant's claim 20 calls for the two stage fishing bobber of claim 18:

“... wherein the resiliently displaceable member comprises a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.”

In rejecting claim 20, the Office held that:

“The patents to Ingram and Behensky show fishing bobbles. Ingram has been discussed above and does not show a spring. The patent to Behensky shows a bobber having a main body 1 and a resiliently displaceable member 10, 15 with a spring 16. In reference to claim 20, it would have been obvious to provide Ingram with a spring as shown by Behensky since merely one mechanical equivalent member is being substituted for another to hold the fishing line in the bobber main body.” (Page 4, lines 11-16 of the Office Action of May 19, 2004.)

The Applicant disagrees with the above. In regards to the Office's statement that “... it would have been obvious to provide Ingram with a spring as shown by Behensky since merely one

mechanical equivalent member is being substituted for another to hold the fishing line in the bobber main body ...,” the Applicant disagrees with the Office’s aforementioned contention. It is submitted that there is no incentive for adding a spring, such as the spring 16 shown by Behensky, to Ingram’s device since Ingram’s device already works for its intended purpose. It is further submitted that there is also no evidence to support that Ingram’s device would be even operable with the addition of the spring 16 shown by Behensky, thereto.

In regards to the replacement of Ingram's stem member 12 and wedge element 18 with Behensky's tube 10, cap member 15, and spring 16, the Applicant submits that replacement of Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16 will destroy the novelty of Ingram’s invention

Ingram in column 1, lines 12 and 19 and column 2, lines 33-34 specifically states that the novelty of his device is by the “nature of its relatively moveable parts,” more specifically, the relative moveability of his stem member 12 with respect to his fishing float body 10. In column 1, lines 13-16 Ingram further discloses that the relative moveability of his stem member 12 with respect to his float body 10 result in:

“... the stem being subject to movement, independent of the float body, upon the striking of a fish on an associated line.” (Emphasis added.)

The independent moveability of Ingram’s stem with respect to his float body 10 allows Ingram's fishing float to provide for an indication of a striking fish “... by the disappearance of the stem within the buoyant body.” (Emphasis added, column 2, lines 27-30.)

Behensky, in column 1, lines 2-6 specifically discloses “a float which is capable of securing and releasing a fishing line to permit adjusting the float in accordance with the depth of the water where it is to be employed.” Behensky accomplishes the above by the use of a spring 16:

“... positioned about the cylindrical tube 10 and bears against the cap member 15 and the shoulder 8 of the cylindrical sleeve 4 to exert an upward force on the tube 10, which urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween.” (Emphasis added, see column 3, lines 25-32.)

In column 3, lines 54-60, Behensky states that in order to displace his tube 10, force is required to be exerted “... on the upper side of the cap member 15, sufficient to overcome the force exerted by the spring 16. (Emphasis added.) Note that Behensky’s tube 10 is displaced with respect to his float body portion 1 to release his fishing float from the line for the purpose of adjustment, that is, the displacement of Behensky’s tube 10 with respect to his float body portion 1 causes “... the flared portion 11 of the tube 10 to move away from tapered seat 9, and to release the line, allowing the float to be positioned at the desired point along the line.” (Column 3, lines 54-60.)

Further note that since Behensky requires sufficient force to be exerted “... on the upper side of the cap member 15 in order to displace his tube 10 with respect to his body portion 1, Behensky's tube 10 does not move independent of Behensky's body portion 1 upon the striking of a fish on Behensky's fishing line 13 as a downward pull on fishing line 13 will not

exert a force on the upper side of Behensky's cap member 15 sufficient to displace Behensky's tube 10. (See column 3, lines 24-33 of Behensky.)

In view of the above, the Applicant submits that providing Ingram with a displaceable member as shown by Behensky would destroy the novelty of the "... relatively moveable parts... " of Ingram's fishing float since Behensky's tube 10 is not permitted to move unless sufficient external force is exerted against the upper side of his cap member 15.

b. Behensky's tube 10, cap member 15, and spring 16 function differently than Ingram's stem member 12

In further regards to the Office's above statement, the Applicant submits that Behensky's tube 10, cap member 15, and spring 16 are not an equivalent mechanical member to Ingram's stem member 12 as Behensky's tube 10, cap member 15, and spring 16 functions differently than Ingram's stem member 12.

In column 2, lines 20-30, Ingram discloses that "... as a fish strikes the lower end of the line, ..." the relatively movable parts of his fishing float allows for the downward displacement of his stem member 12 followed by the downward displacement of Ingram's float body 10.

Thus the striking of a fish is indicated, first, by the disappearance of the stem within the buoyant body and, secondly, by the disappearance of the entire float. In contrast, as illustrated by Figures 11-13 the Applicant's disclosure, the Applicant's stem 13 and bobber body 15 simultaneously submerge in one continuous action due to the gradual resistance to submersion provided by Applicant's fishing bobber.

Behensky's tube 10, cap member 15, and spring 16 do not cooperate with the rest of the parts of Behensky's fishing float to perform the above. As previously noted, a downward pull on Behensky's fishing line 13 will not exert sufficient force on the upper side of Behensky's cap member 15 to downwardly displace Behensky's tube 10 with respect to his body portion 1.

However, even if Behensky's tube 10 is downwardly displaced, the downward displacement of Behensky's tube 10 with respect to his body portion 1 is not followed by the downward displacement of Behensky's body portion 1 as the downward displacement of Behensky's tube 10 with respect to his body portion 1 will release the hold of his fishing float's on line 13. As a result, fishing line 13 will move independent of Behensky's fishing float thereby preventing the downward displacement of Behensky's body portion 1.

c. Behensky's tube 10, cap member 15, and spring 16 are contrary teaching to Ingram's stem member 12

The Applicant also submits that the combination of Behensky's tube 10, cap member 15, and spring 16 is not an equivalent mechanical member to Ingram's stem member 12 but instead is a contrary teaching.

In column 2, lines 20-26, Ingram discloses that:

“... as a fish strikes the lower end of the line, the attached stem will move downwardly through the bore of the body until the top of the stem is flush with the top surface of the body; the body then is subjected to the downward pull on the line and will disappear from sight below the surface of the water.”

That is, Ingram's stem member 12 maintains a hold on the fishing line while the stem member 12 is displaced with respect to the float body 10. The continual hold on the fishing line by Ingram's stem member 12 allows for further displacement of Ingram's float body. (Also see Figures 1-3 of Ingram.)

Behensky, on the other hand, discloses that his spring 16:

“... urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween.” (Emphasis added, see column 3, lines 25-32.)

The displacement of Behensky's tube 10 with respect to his body portion 1 causes “... the flared portion 11 of the tube 10 to move away from the tapered seat 9, and to release the line.” (Column 3, lines 56-60.) That is, contrary to the teaching of Ingram, the displacement of Behensky's tube 10 with respect to his body portion 1 results in the releasing of his fishing float's hold on the fishing line. As a result, the displacement of Behensky's tube 10 prevents the displacement of Behensky's body portion 1.

d. No motivation, suggestion or incentive to the combination

In further regards to the above, the Applicant submits that there is no suggestion, motivation, or teaching in Ingram and Behensky that would lead to their combination, and more specifically, to the replacement of Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16.

The device of Ingram is directed to a fishing float having a stem that is independently moveable with respect to the float body to allow the fishing float to provide for an indication of a striking fish "... by the disappearance of the stem within the buoyant body." (Emphasis added, column 2, lines 26-30.) Note that the displacement of Ingram's stem member 12 is followed by the displacement of the float body 10.

The device of Behensky is direct to "... a float which is capable of securing and releasing a fishing line to permit adjusting the float in accordance with the depth of the water where it is to be employed." (Emphasis added, see column 1, lines 2-6.) Note that Behensky's fishing float requires sufficient force to be exerted "... on the upper side of the cap member 15 in order to displace his tube 10 with respect to his body portion 1.

Behensky does not provide for an indication of a striking fish prior to the downward displacement of his float body portion 1 as Behensky's tube 10 does not move independent of Behensky's body portion 1 upon the striking of a fish on his fishing line 13. The downward pull on Behensky's fishing line 13 also will not exert a force on the upper side of Behensky's cap member 15 sufficient to downwardly displace Behensky's tube 10.

Note that the displacement of Behensky's tube 10 with respect to his body portion 1 results in his fishing line 13 being release from his fishing float. As a result, unlike Ingram's fishing float, the displacement of Behensky's tube 10 with respect to his body portion 1 is not followed by the displacement of Behensky's body portion 1. Further note that Ingram is not

concerned with the adjustment of his float in accordance with the depth of the water where it is to be employed per his simple use of wedge 18 to secure his fishing float to the fishing line.

In *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, the Court of Appeals Federal Circuit held that:

“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” Emphasis added, see *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001)

In view of the above, the Applicant submits that there is no suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to replace Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16.

B. It would not have been obvious to combine Ingram with Behensky due to the Simplicity versus Complexity of the two devices

The Applicant further submits that it would not have been obvious to replace Ingram's wedge 18 and tube 13 with Behensky's spring 16, tube 10 and hollow cylindrical sleeve 4 as Ingram teaches away from Behensky's system for securing a fishing line to Behensky's fishing float.

In column 2, lines 35-36, Ingram discloses that his invention “... is characterized by it simplicity of construction.” (Emphasis added) Note that Ingram's disclosure of “... a fishing float comprising a relatively stationary float body have a vertically movable stem ...” with the stem having “... an internal open line-receiving tube 13 ...” follows Ingram's simplicity of

construction. Further note that Ingram's use of the wedge 18 for securing his float to a fishing line also follows Ingram's simplicity of construction.

Behensky, on the other hand, discloses his fishing float as having a "... unique structure which is readily adjustable along a fishing line; practicable for use in deep water fishing." (Emphasis added, see column 1, lines 32-35 of Behensky.) Note that Behensky's discloses that his system for securing a fishing line to his fishing float alone includes (1) a cylindrical tube 10 having a cap 15 and a lower flared portion 11, (2) a "... hollow cylindrical sleeve 4 having an enlarged lower end portion 5 ..." (col. 2, lines 45-47), with the sleeve having an internal diameter that "... decreases in diameter to form a shoulder 8 ..." (col. 3, lines 3-7), and (3) a spring 16 "... positioned about the cylindrical tube 10 ..." and bearing "... against the cap member 15 and the shoulder 8 of the cylindrical sleeve 4 to exert an upward force on the tube 10" (col. 3, lines 25-30). (Emphasis added.) Applicant submits that Behensky's above system for securing his fishing float to the fishing line goes against Ingram's simplicity of construction.

In view of the complexity of Behensky's above "system" for securing the fishing line to his fishing float, the applicant submits that it would not have been obvious to replace Ingram's wedge 18 and tube 13 with Behensky's above "system" as the replacement of Ingram's wedge 18 and tube 13 with Behensky's above "system" would destroy the simplicity of construction that is characterized by Ingram's fishing float.

C. Hindsight reconstruction

The Applicant further submits that by adding Behensky's spring to the device of Ingram that the Office is using impermissible hindsight reconstruction by simply picking isolated elements from each distinct invention of the prior art and combining them to yield the Applicant's invention as disclosed in dependent claim 20. In the case of *In re Fine*, the C.A.F.C. held:

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” Emphasis added, see *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

The Applicant also submits that even if one were to combine the references of Ingram and Behensky, their combination still does not make the applicant's claim 20 obvious.

Applicant's claim 20 calls for:

“... the resiliently displaceable member comprises a spring having a spring constant that is about equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.” (Emphasis added.)

It is submitted that the combination of Ingram and Behensky does not teach the total force to compress the spring as being “... approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.”

D. The combination of the references of Ingram and Behensky does not teach a spring whose constant is about equal to the spring constant of the bobber in water

The Applicant also submits that the combination of the references of Ingram and Behensky does not teach a spring whose constant is about equal to the spring constant of the bobber in water. In regards to the reference of Ingram, as previously noted, the reference of Ingram does not teach the use of a spring. In regards to the reference of Behensky, the Applicant submits that a reviewed Behensky revealed that Behensky fails to teach "... a spring whose constant is about equal to the spring constant of the bobber in water ..." as called for in Applicant's claim 20. The reference of Behensky instead, teaches a spring 16 for exerting "an upward force on the tube 10, which urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween." (Column 1, lines 25-32.) Note that the force exerted by Behensky's spring 16 is sufficient to urge his flared portion 11 towards his "... tapered seat 9 of sleeve 4 to firmly grip a line passing therebetween." (See column 3, lines 25-33 and column 3, lines 53-60.)

Applicant submits that a spring having a constant "... equal to the spring constant of the bobber in water..." as called for in Applicant's claim 20 is directed away from Behensky's spring having a force sufficient to urge his flared portion 11 towards the tapered seat 9 of his sleeve 4 "... to firmly grip a line passing therebetween."

The Applicant further submits that Behensky is not concerned with a spring having a total force of compression approximately equal to the total force require to submerge Behensky's tube 10 and body portion 1. Note in column 3, lines 25-33 and column 3, lines 53-60 wherein

Behensky discloses the force exerted by Behensky's spring 16 as being the force necessary to urge Behensky's flared portion 11 towards his "... tapered seat 9 of sleeve 4 to firmly grip a line passing therebetween." Applicant submits that the force necessary to urge Behensky's flared portion 11 to firmly grip a line is not the same as the total force require to submerge Behensky's tube 10 and body portion 1.

It is for the above reasons that the Applicant submits that Applicant's claim 20 is allowable over the combination of the reference of Ingram and Behensky.

In regards to Applicant's claims 19 and 20, claims 19 and 20 each depend on independent claim 18. Since independent claim 18 is allowable for the reasons given above, Applicant submits that dependent claims 19 and 20 are also allowable.

In view of the above, it is submitted that the application is in condition for allowance.

Allowance of claims 18-20 is respectfully requested. Applicant has enclosed a marked-up version of the amendment showing changes made with this response. Please charge Account No. 10-0210 for any fee deficiency.

VERSION OF AMENDMENTS SHOWING MARKINGS

In the Claims

1-17. (Canceled)

18. (Original) A two-stage fishing bobber responsive to different fishing forces comprising:

a bobber main body, said bobber main body providing a buoyant force to normally maintain the bobber main body in a floating condition; and

a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.

19. (Previously Amended) The two stage fishing bobber of claim 18 wherein the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.

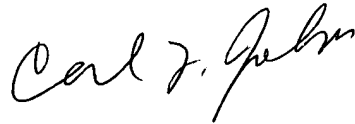
20. (Previously Amended) The two stage fishing bobber of claim 18 wherein the resiliently displaceable member comprises a spring having a spring constant that is about

equal to the spring constant of the bobber in water or the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.

Respectfully submitted,

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